

REMARKS

The Examiner in the Official Action has finally rejected claims 1-12 in the instant application. Currently, there are only two independent claims, claim 1 and claim 5 upon which the remaining claims depend at least ultimately. Claim 1 is directed to a method of making an authentication product which includes the steps of providing a first product, applying a plurality of micro-discrete image products where each of the micro-discrete image products have a size no greater than about 20 microns and having at least one predetermined image thereon wherein the image has a size no greater than about 10 microns. Independent claim 5 as amended is directed to a product upon which a plurality of micro-discrete particles have been placed wherein the micro-discrete particles have a size no greater than about 20 microns, at least a portion of a micro image placed thereon wherein the micro image has a size no greater than about 10 microns.

Applicants have amended independent claims 1 and 5 for purpose of clarity, in particular claim 1 has been amended to specifically refer to each of the micro-discrete products applied to the first product having a size no greater than about 20 microns. The amendment to this claim is more for grammatical consistency. Claim 5 has been amended to set forth that the micro image is smaller than the particle on which it is placed.

It can be seen that the present invention is directed to a combination of two distinct products. First, there is provided a first product on which there is applied a plurality of micro-discrete image products. These are two separate and distinct items. As illustrated by Figure 7, and on page 8 lines 12-13, micro-discrete particles 40 are adhered to fibers of an article 48. Thus, it can be seen that these are two separate and distinct items and not one in the same.

A brief summary of what is required to establish a *prima facie* case of obviousness is set forth in MPEP 706.02(j) which states:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must

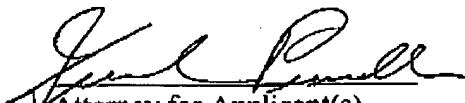
both be found in the prior art and not based on applicant's disclosure ... The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."

In the present instance, the prior art clearly fails to teach or suggest all the elements of the claimed invention and further the Examiner has failed to teach or suggest why the prior art could be modified to arrive at Applicant's invention. As previously noted, the independent claims require two separate and distinct articles that are placed together. The Royer reference discloses a single product on which marks are provided thereon. Thus, clearly there is not shown two separate and distinct products as taught and claimed by Applicant. Furthermore, there is nothing to teach or suggest the providing of micro-discrete particles having a size no greater than about 20 microns and having at least one predetermined image wherein the predetermined image has a size no greater than 10 microns. At best, the Royer reference discloses a single article having a marking thereon the size of which is totally apart and distinct from that of the present invention.

There is no teaching or suggestion in the Royer reference of providing two separate and distinct products that are placed together. Quite the contrary, what Royer teaches is a single product having indicia formed thereon. The Examiner has stated that the references fail to show certain features of Applicant's invention as noted, however the Examiner states that limitations from the specification are not read into the claims, however, Applicants have pointed out to specific limitations in the claims not taught or suggested by Royer. Applicant respectfully submits that the claims provide definite limitations not found in the prior art. The Royer reference does not teach or suggest providing two different products wherein one of the products are of such a small nature that their visual appearance goes unnoticed under normal viewing conditions. As set forth in claim 1 the invention is directed to a method of making an authentication product wherein there is provided a first product on which the micro-discrete image products are provided. There is no teaching or suggestion to providing an authentication product in the manner taught and claimed by Applicant.

In summary, Applicant respectfully submit that the claims in the present form are not taught or suggested by the prior art and therefore are in condition for allowance.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.